

TTAB

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

JENEIL BIOTECH, INC.
(a Wisconsin Corporation)

Opposer

v.

NATURE SOY, INC.
(a Pennsylvania Corporation)

Applicant

Opposition No.: 91152705

Trademark: NATURE'S SOY
Serial No. 76/154423



03-01-2004

U.S. Patent & TMO/TM Mail Rpt Dt. #78

AMENDMENT AFTER PUBLICATION

Assistant Commissioner for Trademarks
BOX TTAB - NO FEE
2900 Crystal Drive
Arlington, VA 22202-3513

Sir:

Please amend Applicant's identification of goods. At the beginning of original identification of goods add – *Soy and soy-based finished goods sold to retailers, distributors and food service operations, namely, –.*

Amended identification of goods should read:

Soy and soy-based finished goods sold to retailers, distributors and food service operations, namely, tofu, fried soybean, soy-based food beverage used as a milk substitute, soy pudding, margarine, milk, cream, yogurt, cheese, cottage cheese, butter

REMARKS

This application was published for opposition on July 23, 2002 and has been opposed by

Jeneil Biotech, Inc. in an Opposition assigned Number 91152705 filed on August 14, 2002.

Opposer's application for registration, Serial Number 76/442,724, was filed on August 19, 2002 for the word mark consisting of NATURSOY. Opposer's identification of goods include the following:

Soy products, namely, powdered soy-based milk substitute sold wholesale to manufacturers

Applicant's above amended identification of goods and Opposer's identification of goods were agreed to between the parties in a Trademark Co-Existence and Consent Agreement executed in November, 2003. A copy of the Trademark Co-Existence and Consent Agreement is attached hereto.

Attorney, Kent A. Lee, attorney of record for Opposer in this proceeding, has consented to the requested amendment, as it is consistent with the above referenced Agreement, during a phone discussion with the undersigned Counsel for Applicant, on February 24, 2004.

Applicant requests that the Board approve this amendment and remand the application to the Examiner-Attorney after Opposer formally dismisses Opposition so that a registration may issue forthwith on the application.

Respectfully submitted,

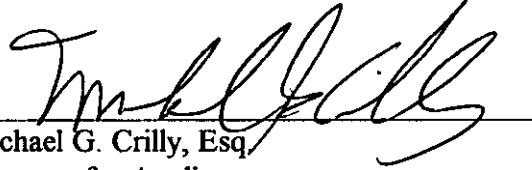


Attorney for Applicant
Michael G. Crilly, Esq.
104 South York Road
Hatboro, PA 19040
Phone No. 215-672-6220
Fax No. 215-672-1639

Date: March 1, 2004

CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as Express Mail No. EL948276755US in an envelope addressed to: Assistant Commissioner for Trademarks, Box TTAB - No Fee, 2900 Crystal Drive, Arlington, VA 22202-3513, on March 1, 2004.

A handwritten signature in black ink, appearing to read "Michael G. Crilly", is written over a horizontal line.

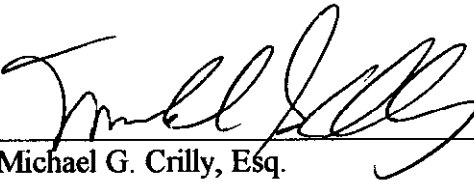
Michael G. Crilly, Esq.
Attorney for Applicant

CERTIFICATE OF SERVICE

I hereby certify that a copy of the foregoing AMENDMENT AFTER PUBLICATION, Opposition No. 91152705, was served upon Counsel for Opposer via First Class mail, postage prepaid, addressed as follows:

Kent A. Lee, Esquire
REINHART BOERNER VAN DEUREN s.c.
1000 North Water Street, Suite 2100
Milwaukee, WI 53202-3186

on March 1, 2004.

A handwritten signature in dark ink, appearing to read "Michael G. Crilly", is written over a horizontal line.

Michael G. Crilly, Esq.
Attorney for Applicant

TRADEMARK CO-EXISTENCE AND CONSENT AGREEMENT

THIS AGREEMENT is by and between Jeneil Biotech, Inc., a Wisconsin corporation having its principal place of business at 400 N. Dekora Woods Blvd., Saukville, WI 53080 ("Jeneil") and Nature Soy, Inc., a Pennsylvania corporation having its principal place of business at 713 North 10th Street, Philadelphia, Pennsylvania 19123 ("Nature Soy"). (Jeneil and Nature Soy are sometimes referred to hereinafter collectively as the "Parties" and each individually as a "Party")

RECITALS

The following circumstances have given rise to this Agreement:

A. Since at least as early as June 24, 1999, Jeneil has used the mark "NATURSOY" in connection with the sale of soy products. On August 19, 2002, Jeneil filed an U.S. federal trademark application (Serial No. 76/442724) for use in connection with soy products.

B. Articles of incorporation were filed for Nature Soy, Inc. on January 11, 1999. Nature Soy sold soy products clearly displaying the corporate name "Nature Soy, Inc." at least as early as June 11, 1999.

C. On October 26, 2000, Nature Soy filed a U.S. federal intent-to-use trademark application (Serial No. 76/154423) for "NATURE'S SOY" for use in connection with said "tofu, fried soybean, soy-based food beverage used as a milk substitute, soy pudding, margarine, milk, cream, yogurt, cheese, cottage cheese, butter". On November 30, 2001, Nature Soy filed an U.S. federal intent-to-use trademark application (Serial No. 76/343143) for "NATURE'S SOY & design" for use in connection with said goods. Since at least as early as March 19, 2001, Nature Soy has used the mark "NATURE'S SOY" in connection with goods.

D. On August 14, 2002, Jeneil filed a Notice of Opposition of Nature Soy's "NATURE'S SOY" trademark application (Opposition No. 91152705). On October 11, 2002, Jeneil filed a Notice of Opposition of Nature Soy's "NATURE'S SOY & design" trademark application (Opposition No. 91155413) (the "Oppositions").

E. The Parties wish to confirm and memorialize in this Agreement their respective concurrent rights to use their respective marks, so as to avoid any disputes between themselves, and any likelihood of confusion among consumers of their services, in the future.

AGREEMENTS

In view of the foregoing, and in consideration of the mutual undertakings set forth herein and other good and valuable consideration, the Parties agree that:

1. The Parties believe that there will be no likelihood of confusion as to the source of each Party's goods since each Party offers different types of soy products that are marketed through different channels of trade.

2. The Parties also believe that there will be no likelihood of confusion as to source of goods so long as the terms of this Agreement are complied with. The Parties recognize and agree that compliance with the provisions of this Agreement will prevent conflict between their respective marks, and will preclude any likelihood that consumers will confuse the marks with one another.

3. The Parties agree to cooperate and consult with one another, in good faith, should future conditions or developments suggest to either the possibility that the Parties' respective marks might be likely to be confused with one another, all with the view of ensuring that no likelihood of confusion between the Parties' respective marks, as they are used in commerce, shall occur.

4. In the United States, Jeneil will only use the mark "NATURSOY" in connection with "soy products, namely, powdered soy-based milk substitute sold wholesale to manufacturers."

5. In the United States, Nature Soy will only use the "NATURE'S SOY" and "NATURE'S SOY & design" marks in connection with "soy and soy-based finished goods sold to retailers, distributors and food service operations namely, tofu, fried soybean, soy-based food beverage used as a milk substitute, soy pudding, margarine, milk, cream, yogurt, cheese, cottage cheese, butter "

6. Jeneil consents to Nature Soy's registration and use of "NATURE'S SOY" (Serial No. 76/154423) and "NATURE'S SOY & design" (Serial No. 76/343143) trademark. Nature Soy consents to Jeneil's registration and use of "NATURSOY" (Serial No. 76/442724). Each Party may seek additional state or federal registrations of their respective trademarks, so long as such applications do not seek registration of marks or rights in conflict with provisions of this Agreement.

7. Upon execution of this Agreement, Jeneil agrees to formally stay the Oppositions pending the acceptance of the "NATURSOY" trademark application (Serial No. 76/442724) by the U.S. Patent and Trademark Office. Within 2 weeks of receipt of acceptance of Jeneil's "NATURSOY" trademark application by the U.S. Patent and Trademark Office (the "PTO"), Jeneil agrees to formally dismiss the Oppositions. In the event that Jeneil's "NATURSOY" trademark application is not accepted by the PTO on the basis of likelihood of confusion with Nature Soy's "NATURE'S SOY" (Serial No. 76/154423) or "NATURE'S SOY & design" (Serial No. 76/343143) trademark applications, the Parties agree to cooperate in good faith to provide the PTO with the necessary evidence to demonstrate that there is no likelihood of confusion. In the event that Nature Soy's "NATURE'S SOY" application or "NATURE'S SOY & design" application is not accepted by the PTO on the basis of likelihood of confusion with Jeneil's "NATURSOY" (Serial NO. 76/442724) trademark application, the Parties agree to cooperate in good faith to provide the PTO with the necessary evidence to demonstrate that there is no likelihood of confusion.

8. The Parties agree that, so long as the obligations of this Agreement are fully complied with, they will not pursue any claim against the other relating to use of their respective trademarks, including but not limited to Opposition and Cancellation proceedings.

9. Both Parties to this Agreement may license or assign their respective rights hereunder, in whole or in part, provided that such license or assignment is consistent with the terms of this Agreement.

10. This Agreement constitutes a contract made under the laws of the State of Wisconsin, and shall be interpreted and construed in accordance with such laws.

11. This Agreement may be signed in multiple copies. Each copy shall be considered an original for all purposes.

12. Upon execution of this Agreement, as set forth in the following section, the Parties shall cooperate to the end that each Party who desires its mark to be registered or its registration to be maintained shall promptly obtain or maintain such registration in a manner not inconsistent with the provisions of this Agreement.

In consideration of the foregoing, the Parties have each caused this Agreement to be signed by their respective, duly authorized officers on the dates set forth below their respective signatures, the Agreement to be effective upon execution by all parties; the date of the Agreement is to be the latest date there set forth.

JENEIL BIOTECH, INC.

NATURE'S SOY, INC.

By: [Signature]

By: [Signature]

N. N. CHANDER, President
[Name, Title]

YAT SUN WEN, PRESIDENT
[Name, Title]

Dated: 11/6/03

Dated: 10-24-03